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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,972	01/16/2004	James Stoffer	423.027US1	6512

7590 12/31/2008  
Schwegman, Lundberg, Woessner & Kluth, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402

EXAMINER
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RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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12/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



Continuation of Disposition of Claims: Claims pending in the application are 1-8,10-31,35,39-59,61,62,67-70,121,122,132,133,139,141,143-145,147-151,154-168,184,186,187 and 191.

Continuation of Disposition of Claims: Claims rejected are 1-8,10-22,30,31,35,39-59,61,62,67-70,121,122,132,133,139,141,143-145,147-151,160,161,164-168,184,186,187 and 191.

### **DETAILED ACTION**

1. All outstanding rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 9/24/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

#### ***Claim Rejections - 35 USC § 103***

4. Claims 1-8, 10-20, 30, 31, 56-59, 61, 62, 67-69, 139, 141, 143-145, 147-150, 164-168, and 184 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780).

The discussion with respect to Shoji et al in paragraph 11 of Office action mailed 10/19/2006 and is incorporated here by reference.

With respect to the newly added limitation that the composition is "capable of curing by air drying," Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group.

5. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Oakes (US 4,370,256).

The discussion with respect to Shoji et al and Oakes in paragraph 12 of Office action mailed 10/19/2006 and is incorporated here by reference.

Art Unit: 1796

With respect to the newly added limitation that the composition is “capable of curing by air drying,” Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group.

6. Claims 35, 39-52, 54, 55, 70, 121, 122, 132, 133, 151, 160, 161, 186, and 187 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Reuter et al (US 2003/0082368).

The discussion with respect to Shoji et al and Reuter et al in paragraph 9 of Office action mailed 8/14/2007 and is incorporated here by reference.

With respect to the newly added limitation that the composition is “capable of curing by air drying,” Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group.

7. Claims 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Reuter et al (US 2003/0082368) and further in view of Tucker (US 3,837,894).

The discussion with respect to Shoji et al, Reuter et al, and Tucker in paragraph 10 of Office action mailed 8/14/2007 and is incorporated here by reference.

With respect to the newly added limitation that the composition is “capable of curing by air drying,” Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group.

Art Unit: 1796

8. Claims 191 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Reuter et al (US 2003/0082368) and further in view of Koefod (US 5,531,931).

The discussion with respect to Shoji et al, Reuter et al, and Koefod in paragraph 11 of Office action mailed 8/14/2007 and is incorporated here by reference.

With respect to the newly added limitation that the composition is “capable of curing by air drying,” Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group.

### ***Double Patenting***

Two (2) obviousness-type double patenting rejections are set forth below.

9. Applicant’s statement on page 16 of the amendment filed 9/24/2008 regarding the provisional obviousness-type double patenting rejections is acknowledged. If the following double-patenting rejection is the only rejection remaining in this application and if there is a provisional obviousness-type double patenting rejection in the later-filed copending application, per USPTO practice, the examiner will withdraw the rejection.

### ***Double Patenting, I***

10. Claims 1-7, 15, 17, 35, 42-45, 70, and 151 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 39-41 of copending Application No. 10/758,973 (published as US 2004/0186201).

Art Unit: 1796

The rejection is adequately set forth in paragraph 13 of Office action mailed on 6/9/2008 and is incorporated here by reference.

*Double Patenting, II*

11. Claims 1, 13, and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 11/036,416 (published as US 2006/0063872).

The rejection is adequately set forth in paragraph 15 of Office action mailed on 6/9/2008 and is incorporated here by reference.

12. Claims 1, 13, and 14 are directed to an invention not patentably distinct from claim 13 of commonly assigned copending Application No. 11/036,416 (published as US 2006/0063872).

The discussion in paragraph 16 of Office action mailed on 6/9/2008 is incorporated here by reference.

***Response to Arguments***

13. Applicant's arguments filed 9/24/2008 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Shoji et al fails to disclose a composition that is capable of curing by air drying; (B) that there is evidence that this present invention fills a long felt need in the field; and (C) that there is evidence of commercial success of a product covered by present invention.

Art Unit: 1796

With respect to argument (A), Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group. Applicant has cited col. 11, lines 19-33 of Shoji et al which discloses heating to surface treat to establish that Shoji et al fails to teach a composition that capable of curing by air drying, however, the examiner has cited another aspect of Shoji et al's invention ("third aspect" starting on col. 12, line 21) which is not associated with col. 11, lines 19-33. Therefore, Shoji et al teaches a composition that is capable of curing by air drying.

With respect to argument (B), the declarations of Richard Albers and Charles J. Ray, each filed on 9/24/2008, have been fully considered; however, they are insufficient to establish that the present invention fills a long-felt but unsolved need because the product used in the declaration is not reasonably commensurate in scope with the scope of the claims. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Specifically, the declaration only refers to a corrosion inhibiting coating composition that contains binder, 4.7-13 wt % praseodymium oxide, and 36.2-55.6 wt % calcium sulfate--wherein the type of organic binder is not disclosed. The instant independent claims are much broader in scope and include embodiments that are not represented in the declarations. Furthermore, the primers of the declarations are only used with metal substrates and cannot serve to establish a long-felt but unsolved need for a composition used on all types of substrates.

With respect to argument (C), the declaration of Charles J. Ray filed on 9/24/2008 has been fully considered, however, it is insufficient to establish that the present invention is commercially successful given that the data is not reasonably commensurate in scope with the



Art Unit: 1796

scope of the claims. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Specifically, the declaration only refers to a corrosion inhibiting coating composition that contains binder, 4.7-13 wt % praseodymium oxide, and 36.2-55.6 wt % calcium sulfate--wherein the type of organic binder is not disclosed. The instant independent claims are much broader in scope and include embodiments that are not represented in the declaration. Furthermore, the primers of the declarations are only used with metal substrates and cannot serve to establish a commercial success for a composition used on all types of substrates.

Furthermore, there is a lack of evidence regarding the market share. A statement that “Def’t” is “effectively 100% of the current marketshare for new F-35 and F-22 Aircraft, and 100% of the marketshare for future F-15 Aircraft” is not a substitute for factual evidence.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1796

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/23/2008  
Vickey Ronesi

/V. R./  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796